

REMARKS/ARGUMENTS

In the Office Action mailed December 11, 2007 (hereinafter, “Office Action”), claims 1-4, 9-15, 20-24, 29-30, 34-35 and 39-45 stand rejected under 35 U.S.C. § 102. Claims 6-8, 17-19, 26-28, 31-33 and 36-38 stand rejected under 35 U.S.C. § 103. Claim 21 has been amended.

Applicant respectfully responds to the Office Action.

I. Claims 1-4, 9-15, 20-24, 29-30, 34-35 and 39-45 Rejected Under 35 U.S.C. § 102(b)

Claims 1-4, 9-15, 20-24, 29-30, 34 and 39-45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,125,283 to Kolev et al. (hereinafter, “Kolev”). This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1 recites “determining which communications networks from the plurality of available communications networks support the call based upon the parameters, thereby identifying compatible networks.” Regarding the parameters, claim 1 recites “including parameters that include a service parameter and a dialing string.” Kolev does not disclose this subject matter.

Instead Kolev states:

Referring now to the embodiment illustrated in FIG. 4, the user terminal 60 is a radiotelephone, such as a dual-mode radiotelephone, capable of communicating with the satellite communications system 40 and the terrestrial communications system 20. The user terminal 60 may operate as a satellite radiotelephone or the user terminal 60 may switch between satellite and terrestrial modes under user control or automatically. The user terminal 60 includes an antenna 62 and transceiver 64 or other transceiver means for transmitting and receiving communications to/from the satellite network and/or the terrestrial network.

Kolev, Col. 6, lines 18-28.

This portion of Kolev cited by the Office Action does not disclose “determining which communications networks from the plurality of available communications networks support the call based upon the parameters, thereby identifying compatible networks.” It is again noted that the parameters in claim 1 “include a service parameter and a dialing string.” This portion of Kolev, as best understood, discloses “a dual-mode radiotelephone capable of communicating with the satellite communications system 40 and the terrestrial communications system 20.” (Kolev, Col. 6, lines 19-22.) However claim 1 does not simply recite a dual-mode radiotelephone. Kolev’s disclosure that “the user terminal 60 may switch between satellite and terrestrial modes under user control or automatically” further does not disclose this subject matter of claim 1, namely, “determining which communications networks from the plurality of available communications networks support the call based upon the parameters, thereby identifying compatible networks.”

Moreover, with respect to this claim subject matter, Kolev does not disclose “determining which communications networks . . . support the call based upon the parameters, thereby identifying compatible networks.” (Emphasis added.) Regarding the “service parameter” as recited in claim 1, the Office Action cited the following:

The processor 66 accepts and provides information to and from the transceiver 64 and selects a control channel for the user terminal 60 to communicate with the satellite communication network 40 or terrestrial network 20. The user terminal memory 68 stores information related to the satellite communication network 40 and the terrestrial communication network 20. The user interface 70 may include a key pad by which the user may control the operation of the user terminal 60. User terminal 60 may also include a Subscriber Identification Module (SIM) 72 containing a subscriber identity which may be used to control access to the satellite communication network 40 and/or the terrestrial communications network 20.

Processor 66, according to the present invention, implements the no-valid-SIM operations according to the present invention. Processor 66 provides means for determining if the first network available to the mobile terminal allows access without a valid subscriber identity (or the level of service available) and means for determining if the second network available to the mobile terminal allows access with a valid subscriber identity (or the level of service available).

Kolev, Col. 6, lines 28-49.

This portion of Kolev does not disclose “determining which communications networks . . . support the call based upon the parameters, thereby identifying compatible networks.” (Emphasis added.) Claim 1 earlier recited “receiving an origination request for a call, including parameters that include a service parameter and a dialing string.” Thus, the “service parameter” is included with the “origination request for a call.” As a result, the “service parameter” depends on the “origination request for a call.” This portion of Kolev cited by the Office Action does not disclose “determining which communications networks . . . support the call based upon the parameters, thereby identifying compatible networks.” (Emphasis added.) These paragraphs of Kolev appear to simply disclose “a Subscriber Identification Module (SIM) 72 containing a subscriber identity which may be used to control access to the satellite communication network.”

Regarding the “service parameter” as recited in claim 1, the Office Action also cited the following:

The user is also prompted at block 102 to switch to terrestrial mode. User communications may be performed via the mobile terminal user interface 70 and may involve the display of text or images, audio signals or other input output means.

Kolev, Col. 9, lines 20-24.

This portion of Kolev does not disclose a “service parameter”, nor does it disclose “determining which communications networks . . . support the call based upon the parameters, thereby identifying compatible networks.” (Emphasis added.) The specification of Applicant includes examples of service parameters as follows: “service parameters typically include, among other things, the type of service requested. For example, the requested service can be a voice call, a data call, or any other service provided by the carrier.” (Specification, para. [0027].)

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Kolev. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Kolev does not disclose all of the subject matter of claim 1.

Claims 2-4 and 9 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2-4 and 9 be withdrawn.

Claims 10, 12, 21, 29, 30, and 34 include the same or similar claim subject matter as argued above with respect to claim 1. Since claim 1 is allowable under 35 U.S.C. §102(b),

independent claims 10, 12, 21, 29, 30, and 34 are allowable for at least the same reasons. Therefore, Applicant respectfully requests that the rejection of claims 10, 12, 21, 29, 30, and 34 under 35 U.S.C. § 102(b) be withdrawn.

Claims 11, 13-15, 20, 22-24, 35 and 39-45 depend either directly or indirectly from claims 10, 12, 21, 29, 30, and 34. Accordingly, Applicant respectfully requests that the rejection of claims 11, 13-15, 20, 22-24, 35 and 39-45 be withdrawn.

II. Claims 6-7, 17-18, 26-27, 31-32 and 36-37 Rejected Under 35 U.S.C. § 103(a)

Claims 6-7, 17-18, 26-27, 31-32 and 36-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolev in view of U.S. Patent No. 6,125,283 to Jonsson (hereinafter, "Jonsson"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Claims 6-7, 17-18, 26-27, 31-32 and 36-37 depend directly or indirectly from the independent claims, above. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn for the same reasons as those presented above because Kolev does not teach or suggest all of the subject matter of the independent claims, as argued above.

III. Claims 8, 19, 28, 33 and 38 Rejected Under 35 U.S.C. § 103(a)

Claims 8, 19, 28, 33 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolev in view of Jonsson in further view of U.S. Patent No. 7,010,296 to Sakai et al. (hereinafter, "Sakai"). This rejection is respectfully traversed.

Claims 8, 19, 28, 33 and 38 depend directly or indirectly from the independent claims, above. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn for the same reasons as those presented above because Kolev does not teach or suggest all of the subject matter of the independent claims, as argued above.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that no new matter has been entered by way of this amendment and that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are respectfully requested. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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